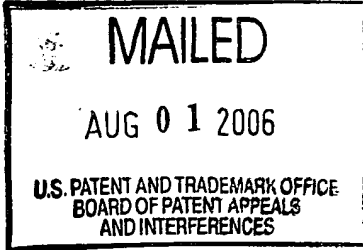


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES K. PRUEITT,
RICHARD A. PINEAU, KEVIN F. BERNIER,
TODD M. LYNTON and SCOTT D. WICKER

Application 09/870,538

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on July 28, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

A review of the Image File Wrapper (IFW) indicates that appellants filed an Appeal Brief on February 27, 2006 primarily using the format set forth in 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on

September 13, 2004, and replaced by 37 CFR § 41.37(c). Accordingly, the Appeal Brief does not comply with 37 CFR § 41.37(c).

37 CFR § 41.37 states:

....

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim

involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered

evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

An in-depth review of the Appeal Brief filed February 27, 2006 indicates that the following sections are missing:

- 1) "Summary of claimed subject matter," as set forth in 37 CFR § 41.37(c)(1)(v); and
- 2) "Grounds of rejection to be reviewed on appeal," as set forth in 37 CFR § 41.37(c)(1)(vi);

A substitute brief that is in compliance with § 41.37(c) is required.

For more information, see the United States Patent and Trademark website www.uspto.gov, and, in particular, the web page entitled “More Information on the Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule” located at the following URL:

www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html

In response to the Appeal Brief filed February 27, 2006, an Examiner’s Answer was mailed on April 10, 2006.

Section § 1207.02 of the Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 3, August 2005) states:

Requirements for Examiner’s Answer

The examiner’s answer is required to include, under appropriate headings, in the order indicated, the following items:

. . . .

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

It is noted that while the Examiner’s Answer states that “[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal”

[page 3 under the caption "Evidence Relied Upon"], the claim rejections are listed as follows:

1. Claims 1-3, 5-7,¹ 9, 11, 12, 17-20, 22-24, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klear et al. (WO 01/03040) (hereinafter Klear) in view of Devarics (USPN 6,553,240) in view of Ishizuka (US 2002/006873) [page 3];

2. Claims 4, 8, 13-15, and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klear in view of Devarics in view of Ishizuka as stated in the claims above, and further in view of Fidler (USPN 6,725,051) [page 7];

3. Claims 1-3, 5-7,² 9, 11, 12, 17-20, 22-24, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klear et al. (WO 01/03040) (hereinafter Klear) in view of Devarics (USPN 6,553,240) in view of Cottrell et al. (USPN 5,694,484) (hereinafter Cottrell) [page 9]; and

4. Claims 4, 8, 13-15, and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klear in view of Devarics in view of Cottrell as stated in the claims above, and further in view of Fidler (USPN 6,725,051) [page 13].

Correction is required.

In addition, page 3 of the Examiner's Answer mailed April 10, 2006 includes two new grounds of rejection. However, the Answer is deficient pursuant to § 1207.03 of the Manual of Patent Examining Procedure

¹ It should be noted that claim 6 was cancelled by the Amendment filed June 2, 2005 and should not be included in any rejection.

² See footnote 1.

(MPEP) (Eighth Edition, Rev. 3, August 2005) which states that “[a]ny new ground of rejection made by an examiner in an answer must be:

(A) approved by a Technology Center (TC) Director or designee.”

Correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed February 27, 2006 defective;
- 2) for notification to appellants to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;
- 3) for consideration of the substitute Appeal Brief;
- 4) for submission of a revised Examiner’s Answer which corrects the “Evidence Relied Upon” section;
- 5) for obtaining a Technology Center (TC) Director or designee’s signature on the Examiner’s Answer mailed April 10, 2006; and
- 6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

DALE M. SHAW

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Application No. 09/870,538

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